

BP 78. (Amended) The device of claim 76, wherein the spacer is constructed and arranged to allow one of relative rotation of the deck and runner in the front to back direction and relative longitudinal movement of the deck and runner.

#### REMARKS

In response to the Office Action mailed on May 6, 2002, Applicants respectfully request reconsideration. The claims as presented are believed to be in allowable condition.

Claims 1-48 and 52-99 are pending. Of these, claims 1, 2, 5-8, 10-12, 16, 21-23, 46-48, 52 and 76-78 (a total of twenty claims) are hereby provisionally designated, with traverse, for examination on the merits, of which claims 1, 23, 46 and 76 are independent. Claims 2, 5-8, 10-12, 16, 22 and 78 are amended herein. No new matter has been added.

#### Claim Rejections Under 35 U.S.C. §112

Claims 1-48 and 52-99 were rejected under 35 U.S.C. §112, second paragraph, in view of 37 C.F.R. 1.75(b), on the grounds of multiplicity. Applicants respectfully traverse this rejection.

Relying on In re Chandler, 319 F.2d 211, 225 (C.C.P.A. 1963), the Office Action rejected all pending claims on the grounds of multiplicity, contending that such a rejection is appropriate when the "degree of repetition and multiplicity beclouds definition in a maze of confusion." The Office Action then purports to limit the number of claims that should be examined in this application to twenty in total. As explained below, the Office Action fails to set forth a factual predicate for the multiplicity rejection, let alone a *prima facie* case, and ignores the later decision by the CCPA in In re Flint, 411 F.2d 1353 (CCPA 1969) that informs the appropriate application of the multiplicity rejection discussed in Chandler.

A multiplicity rejection is only appropriate when *the Examiner or public would be confused as to the scope of protection*. In re Flint, 411 F.2d 1353, 1357 (C.C.P.A. 1969). In the present application, the claims do not obfuscate the boundaries of the invention; rather, one of skill in the art reading the claims would be fully and clearly informed as to what is within the patent grant and what is not. One of skill in the art will readily appreciate the distinctions between the four independent claims in the present case, each of which consist only of three

elements. Each of the dependent claims further defines particular features of the respective claimed invention from which they depend. In this case, there is no "maze of confusion" that might support a multiplicity rejection. Thus, as in Flint, there should be "no difficulty in understanding the scope of protection" sought with the present claim set, and the multiplicity rejection should be withdrawn. See also In re Wakefield, 422 F.2d 897 (C.C.P.A. 1963), where the CCPA observed that since "each ... claim is relatively brief and clear in its meaning," a multiplicity rejection was unwarranted. Id. at 900.

One of the stated reasons in the Office Action for the multiplicity rejection was "the repetitive [sic] nature of the claims." Yet no detail is provided as to which claims the Examiner believes to be repetitive of one another, nor the basis for that belief. In the next action, if the multiplicity rejection is not withdrawn, the Examiner should identify those claims that he believes are repetitive of one another and then explain his basis for that assessment. In reconsidering the contention of repetitiveness, Applicants ask the Examiner to focus on the various limitations that appear solely in each independent claim but not in the others. Such distinctions belie any finding that the claims are repetitive of one another. Of course, where there is a difference in scope between the independent claims, "logically the sets of dependent claims differentiate themselves from each other by the differences in scope of the independent claims." Flint, 411 F.2d at 1357.

The Office Action additionally stated that "the number of claims pending for examination is in excess of a reasonable number with which to claim the invention." Firstly, it is noted that the present case includes four independent claims. According to USPTO published data, over 70% of all applications filed in the fiscal year 1997 contained four to six independent claims. Given that the majority of applications filed in a relatively contemporaneous time period include the same or a greater number of independent claims, it is unclear why in this particular case the four independent claims are "unreasonable". With respect to the reasonableness of the number of dependent claims in this case, Applicants remind the Examiner of the statement by the CCPA in In re Wakefield, "[i]t is rarely possible to determine necessity for narrower claims at the time of prosecution. An applicant often does not know all the prior art which may be asserted against his broader claims when he litigates his patent. Further, he is never sure that the broader claims

will not be successfully attacked on other grounds when litigated in the courts.” In re Wakefield, 422 F.2d at 900.

As the Examiner has been informed in other cases that he has handled in the gliding device field, The Burton Corporation (aka Burton Snowboards), assignee of the present application, is a Burlington, Vermont company that is the world leader in the sport of snowboarding. The gliding device field for the last several years has been the fastest growing sport worldwide; not simply the fast growing winter sport, but of any sport and is a billion plus dollar a year industry. The gliding device business is highly competitive. It is commonplace for a gliding device company to secure a patent and then enforce its rights to protect its substantial investment in developing its proprietary technology -- for it is much easier and virtually cost-free for the competition to copy a new product once its been released to the market. Without the ability to safeguard an investment in research and development, companies would be unwilling to spend hundreds of thousands, if not millions, of dollars creating new products, resulting in a decline in innovation in this field. It is in this context that the Examiner should be gauging the reasonableness of the number of claims presented.

The Office Action mentions a burden on the Examiner of having to search 96 claims. The relevance to a multiplicity rejection of having to search a comprehensive claim set was addressed by the CCPA in In re Wakefield: “examination of 40 claims in a single application may be tedious work, but this is no reason for saying that the invention is obscured by the large number of claims.” Id. Further, any additional burden that may be imposed on the Examiner has been addressed by the overall examination fee system promulgated by the USPTO. The examination fee structure expressly contemplates claims in excess of the twenty arbitrarily allotted by the Examiner in this case (See 37 CFR §1.16(a)-(b)). Applicants have paid those substantial additional fees in exchange for the USPTO’s promised examination of the claims. The USPTO should not now renege on that obligation. As observed by the CCPA, “an applicant should be allowed to determine the necessary number and scope of his claims, provided he pays the required fees and otherwise complies with the statute.” Id. So, the burden alone to the Examiner is not a sufficient grounds for rejecting the claims as multiplicitous where the surcharge for additional claims has been paid. Rather, as noted above, the proper test is instead whether the invention is *obscured* by the number of claims presented.

There is no evidence in the record for any of the conclusory findings set forth in the Office Action. Something more than "mere opinion" is required to justify a multiplicity rejection. *See In re Flint*, 411 F.2d at 1356. The Office Action stated that "the number of claims pending for examination is in excess of a reasonable number with which to claim the invention," because "designation of up to the indicated numbers [20] of claims would provide applicant ample latitude in claiming the invention, would be reasonable in view of the state of the art and the nature of the invention, and is necessary to permit a complete examination without the imposition of serious burden on the Office." The statements purportedly supporting the multiplicity rejection are all conclusory. A proper multiplicity rejection requires an evidentiary showing from which a factual basis can be derived to which the applicable legal principle of "multiplicity" may then be applied." *Id.* For example, in *Flint* the Examiner "set forth 'typical examples of substantial duplication or lack of material differentiation,' discussed the relative complexity of the invention, alleged a lack of difference in scope of the claims, and referred to representative prior art." *Id.* at 1356-1357. So the factual predicate was properly laid by the Examiner for the rejection in *Flint*, even though the CAFC ultimately reversed the multiplicity rejection as a matter of law. The Office Action in the present case, in contrast, presents no factual support whatsoever for the multiplicity rejection. The Examiner is requested to explain the factual basis underpinning his determination that the number of claims is unreasonable, that the claims are repetitive, that the state of the art and the nature of the invention inform that twenty claims is reasonable, and that a complete examination cannot occur without the imposition of serious burden on the office, or to withdraw the rejection.

In response to the Examiner's requirement that no more than a total of twenty claims be designated, applicants hereby provisionally select, with traverse, claims 1, 2, 5-8, 10-12, 16, 21-23, 46-48, 52 and 76-78 for examination on the merits. Applicants have amended the dependencies of many of the claims to depend from claim 46.

### **CONCLUSION**

In view of the foregoing amendments and remarks, this application should now be in condition for allowance. A notice to this effect is respectfully requested. If the Examiner

believes, after this amendment, that the application is not in condition for allowance, the Examiner is requested to call the Applicants' attorney at the telephone number listed below.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicants hereby request any necessary extension of time. Please charge any fee occasioned by this response, including any extension fee, to Deposit Account No. 23/2825.

Respectfully submitted,  
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MARKED-UP CLAIMS

2. (Twice Amended) The device of claim 46 [21], wherein the runner and deck are constructed and arranged to provide equivalent riding performance with the first runner end forward and the second runner end forward.
5. (Twice Amended) The device of claim 46 [21], wherein the deck includes uplifted lateral edges that are positioned vertically farther away from the runner than a central portion of the deck.
6. (Twice Amended) The device of claim 46 [21], wherein an angle formed between a plane of a bottom surface of the runner and a line extending between a lower edge of the runner and a lateral edge of the deck is between 30 and 70 degrees.
7. (Twice Amended) The device of claim 46 [21], wherein the upper surface of the deck is arranged for a gripping surface.
8. (Twice Amended) The device of claim 46 [21], further comprising a foam material secured to at least one portion of the upper surface of the deck.
10. (Twice Amended) The device of claim 46 [21], comprising first and second spacers, wherein the first spacer is positioned nearer the first upturned end of the runner and a second spacer is positioned nearer a second upturned end of the runner, wherein the runner has an overall length and the first and second spacers are separated longitudinally by a distance equal to approximately zero to three-fifths the overall length of the runner.
11. (Twice Amended) The device of claim 46 [21], comprising two spacers, wherein the two spacers are longitudinally separated from each other and attach the runner and the deck together, and a portion of the runner between the spacers is free to flex relative to the deck.

12. (Twice Amended) The device of claim 46 [21], wherein the first and second upturned ends of the runner are free to move relative to the deck.

16. (Twice Amended) The device of claim 46 [21], wherein the runner has a width that is approximately 0.4 to 0.8 times a width of the deck, and the deck has a width between 7 and 15 inches.

22. (Twice Amended) The device of claim 46 [21], wherein at least one of the deck and the runner are directly secured to the spacer.

78. (Amended) The device of claim 76, wherein the spacer is constructed and arranged to allow one of relative rotation of the deck and runner in the front to back direction[,] and relative longitudinal movement of the deck and runner.